

REMARKS

Sections 102 and 103 Rejections

Examiner rejected all outstanding claims based on the “Greffrath” paper published in the Journal *Pain* in 2002 that was co-authored by Applicant and Drs. Greffrath, Schwarz, Baumgarner, Vogel, Arendt-Nielsen and Treede. No other prior art reference has been cited by Examiner as disclosing or suggesting the invention as currently claimed.

In his remarks Examiner stated that the Declaration filed on January 14, 2008 under 37 CFR 1.131 was ineffective because the Declaration failed to include the references cited therein. Applicant and his attorney are unsure why the cited attachments were not included. It was certainly the intent of both Applicant and his attorney that they be included. Applicant has attached hereto the copy of the declaration from the files of Applicant’s attorney which does include the attachments. Applicant requests reconsideration by the Examiner of the declaration and its attachments.

These documents along with Applicant’s declaration under oath prove that Applicant conceived the invention prior to his 1999 work with his co-authors which was reported in the 2002 Pain paper and that he pursued his invention diligently from conception to reduction to practice. Also as proven by the attached declaration and its attachments, this 1999 work was actually the second actual reduction to practice of the invention as currently claimed. The first reduction to practice occurred in Saint Petersburg, Russia during the period December 1996 to April 1997.

Examiner in his 02/25/2008 office action stated that two of the co-authors have refused to disclaim inventorship indicating a potential inventorship conflict. Applicant submits there is no potential inventorship conflict. Examiner is correct that the two co-authors have refused to disclaim inventorship; however, none of them have made any claim of inventorship of the invention as claimed by Applicant. Any such claim by the co-authors would be false, so the co-authors are very unlikely to make such a claim.

Conclusion

As previously submitted, the only basis for claim rejection provided by Examiner is that the Applicants have not previously provided adequate data to remove the 2002 Pain paper as prior art. Applicant Nemenov through his attached declaration (including the attachments) has shown facts in sufficient character and weight to establish conception and the required due diligence prior to any collaboration with the above co-authors. These facts also establish that the invention had been actually reduced to practice prior to the collaboration and that the collaboration was only a second “formal” reduction to practice with sufficient formality to permit publication in an important medical journal. Applicant Nemenov therefore submits that the outstanding claims (namely Claims 12 -15,

Claims 17 – 22 and Claims 24 – 31) should now all be allowable and respectfully request that they be allowed and the application allowed to issue as a patent.

Respectfully submitted,



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